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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,693	11/15/2001	James D. Thornsberry	2334-200	7177

7590 09/09/2003

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EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 09/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center"><b>Office Action Summary</b></p>	<p><b>Application No.</b></p> <p>09/987,693</p>	<p><b>Applicant(s)</b></p> <p>THORNSBERRY ET AL.</p>	
	<p><b>Examiner</b></p> <p>Victor S Chang</p>	<p><b>Art Unit</b></p> <p>1771</p>	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 July 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 14-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13,20 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

1. The Examiner has carefully considered Applicant's amendments and remarks filed on 7/9/2003. Applicant's amendments to claims 1-13 and newly submitted claims 20 and 21 have been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn. In particular, the Examiner agrees with Applicants' argument that the Specification has provided two examples of facers, as such the rejection under 35 U.S.C. 112, first paragraph in Paper No. 5 is withdrawn.

#### ***Claim Rejections - 35 USC § 112***

4. Claims 1-13, 20 and 21 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The amount of the selected DBE and a foam composition are <sup>each</sup> critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

More particularly, Applicants Specification at [0017] and Remarks (page 10, bottom paragraph) dated 7/9/2003 appear to have admitted and/or asserted that the specific amount of DBE mixture in the foaming composition is critical for the adhesion improvement. As such, the Examiner suggests to incorporate claims 4 and 5 into claim 1, and also to incorporate claims 10 and 11 into claim 9.

Additionally, in amended claims 1 and 9, line 4 and 5 respectively, the phrase "foam formed from" is clearly erroneous, since the listed mixture of chemicals improves the adhesion of facers to the foam core (Specification, page 1, lines 10-11), but they do not form the foam themselves. Clarification is requested.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-13, 20 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, lines 1-3, (and similarly in claim 9) the phrase "two facers disposed on opposing broad flat surfaces of said board" and "a foam core to which the two facers are adhered" appears vague, indefinite, and redundant. Also, it is noted that the "foam board" is recited in the claim preamble, not in the "comprising" section. The Examiner suggests a re-write so as to clean up the redundancy and the preamble.

7. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicants' admitted prior art in view of DeGuisseppi (US 4335218), substantially for the reasons set forth in section 10 of Paper No. 5, together with the following additional observations.

With respect to Applicant's argument that "the person skilled in the art would not, in seeking to improve adhesion in the spirit of US Patent 4,335,218 to DeGuisseppi, turn to DBE" (Remarks, page 9, second full paragraph) and also argues that DeGuisseppi's teachings of aprotic solvents such as DMF and DMSO are strong solvents, whereas

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"DBE are weak solvents" (Remarks, page 9, bottom paragraph), the Examiner notes that DeGuisseppi also teaches a weak solvent such as O,O-dimethyl methylphosphonate, etc. (column 2, lines 34-53). As such the Examiner repeats (see Paper No. 5, page 6, top paragraph) that it would have been obvious to one of ordinary skill in the art to include a small amount of the low cost weak aprotic solvent mixture such as the methyl esters of glutaric, succinic, and adipic acid in a polyisocyanurate foam formulation, as taught by DeGuisseppi, motivated by the desire to obtain improved adhesion between the facers and the foam core.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 703-605-4296. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 703-308-2414. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

VSC

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP 1300-  
1700

*Daniel Zinker*